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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

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12/20/2002

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23, 48 and 49 is/are allowed.
- 6) ☒ Claim(s) 33-47 and 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Reissue Applications

1. The reissue Declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP 1414.

2. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

3. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.

Claim Rejections - 35 USC § 112

4. Claims 50-55, 57, and 58 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The removability of the resilient sections is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The removability of the sections is a critical and essential feature/limitation required for the footwear to function as desired and disclosed. There is no disclosure as to how the shoe without this feature would function in the desired manner.

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5. Claims 43, and 50-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 43 the phrase "upper footgear surfaces for holding the foot into the footgear" is confusing, vague, and indefinite. How can a surface hold a foot? No structure as such as been disclosed. It is not clear what structural limitations applicant intends to encompass with such language. The argument that the inner surface of flaps hold the foot in the footgear is not persuasive because it is actually the flaps and securing means (46) which performs the function of holding the foot into the footgear and these structural limitations are absent. There is insufficient structure to perform the recited function in the claims.

In claims 50, 57, and 58 the phrase "independently vertically movable resilient sections" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no structural limitations claimed which facilitate the functional recitation of "vertically movable".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 50-52, 54, 55, 57, and 58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuhn (4727661) or Foldes (4095353).

Kuhn or Foldes shows a shoe comprising an outer sole (7 or 23), an inner sole (1 or 22) with a plurality of vertically movable resilient sections (2 or 28) arranged in a grid and that are adjacent one another which sway laterally as claimed.

8. Claims 42-45, 47-52, and 54-58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ma (4598484).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Kuhn, Foldes, or Ma.

Kuhn, Foldes, or Ma shows a shoe substantially as claimed except for the exact shape for the resilient sections. The exact shape of the resilient sections is considered to be a choice of design

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and it would have been obvious to use any shape including hexagonal for design concerns or for ease of production.

11. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of Kuhn.

Ma shows a shoe substantially as claimed except for means for attaching the inner sole to the outer sole. Kuhn teaches providing mating fasteners (snaps) for attaching an inner sole to an outer sole. Hook and loop fasteners are obvious and well known alternative mating fasteners to snaps. It would have been obvious to provide a means for attaching the inner sole to an outer sole as taught by Kuhn and to use hook and loop fasteners as is well known in the shoe of Ma to prevent the innersole from slipping during wear and to allow the inner sole to be removed for cleaning and alterations.

12. Claims 33-38, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078) and Moronaga (4633598).

Kellerman shows a pad/footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer and making the inner sole sections from multiple layers. Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. Moronaga teaches forming an insole pad from three layers with progressively different softnesses. It would have been obvious

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to provide the inserts on the upper surface of the insole/pad as taught by Andrews and to make the insole from three different layers as taught by Moronaga in the pad/footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

13. Claims 39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (5078128) in view of Kellerman and Andrews (4793078).

Grim shows a footgear comprising an outer sole (25), flaps and arrangement with an open toe (shown in figure 6), and an inner sole (200) substantially as claimed except for the exact inner sole. Grim suggests the use of customizing cushion construction in column 3 lines 42-45.

Kellerman teaches customizing cushion construction by providing a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer for relieving pressure at regions of swelling, pain, or inflammation (column 6 lines 4-7). Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers foot. It would have been obvious to provide a pressure relieving insert insole as taught by Kellerman and to provide the removable sections on the upper surface of the insert as taught by Andrews in the footgear of Grim to relieve pressure at sensitive areas of a patients foot and thereby customize the cushion for the specific patient.

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14. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Cavanagh (4608768).

Grim as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Grim as modified above to provide secure and removable attachment for the inner sole.

15. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Moronaga (4633598).

Grim as modified above shows footgear substantially as claimed except for the inner sole being made from three layers. Moronaga teaches forming an inner sole from three layers with progressively different softness. It would have been obvious to make the inner sole sections from layers having different softness as taught by Moronaga in the footgear of Grim as modified above to provide better shock absorption and cushioning.

16. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer.

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Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. It would have been obvious to provide the removable sections on the upper surface of the insole/pad as taught by Andrews in the footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

17. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 42-45 above, and further in view of Cavanagh (4608768).

Kellerman as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Kellerman as modified above to provide secure and removable attachment for the inner sole.

Allowable Subject Matter

18. Claims 1-23, 48, and 49 are allowed.

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Response to Arguments

19. Applicant's arguments filed 9/6/02 and 10/31/02 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the applied references and the newly added phrase "said grid pattern....that sway laterally...", even though the sections may be relatively thin, they still would sway to some, possibly very small degree.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648.

For applicant's convenience, the Group Technological Center FAX number is (703)872-9302 Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted. Please note that the Examiner is unable to confirm or deny receipt of Faxes.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728